

RESPONSE TO OFFICE ACTION  
DATED OCTOBER 3, 2006

Appln. No. 09/744,351

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January 24, 2007

**REMARKS**

This is in response to the Office Action dated October 3, 2006. Reconsideration is respectfully requested.

Request for Extension of Time

Applicants request that the time period for response be extended one month, from January 3, 2007 to February 3, 2007. Payment to a credit card for the one-month extension in the amount of \$60 pursuant to 37 CFR 1.17(a)(i) is authorized on the electronic fee worksheet.

Information Disclosure Statement

Applicants note that various foreign patent publications and "other documents" listed on applicants' "Request to Print References Cited in PCT International Search Report on Any Resulting Patent", dated May 10, 2001 (copy enclosed) were not considered by the Examiner for the reason that "no copies were provided". Applicants note that the publications that were not considered were cited in the International Search Report (ISR) dated August 10, 1999 (copy enclosed). Applicants further note that copies of the references were provided as evidenced by Form PCT/DO/EO/905, "Notification Of Missing Requirements Under 35 USC 371 in the United States Designated/Elected Office" (copy enclosed) which clearly acknowledges receipt by the U.S. Patent Office of a copy of the ISR and copies of the references cited therein. Further acknowledgement of receipt of the ISR and the references cited therein is provided on Form PCT/DO/EO/903, "Notice of Acceptance of Application Under 35 UC 371 and 37 CFR 1.494 or 1.495" dated July 31, 2002 (copy enclosed) which lists, as received, both a copy of the ISR and copies of the references cited in the ISR.

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Applicants cite the MPEP, Section 1893.03(g), which states:

"When all the requirements for a national stage application have been completed, applicant is notified (Form PCT/DO/EO/903) of the acceptance of the application under 35 U.S.C. 371, including an itemized list of the items received. The itemized list includes an indication of whether a copy of the international search report and copies of the references cited therein are present in the national stage file. The examiner will consider the documents cited in the international search report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file. The examiner will note the consideration in the first Office action. There is no requirement that the examiners list the documents on a PTO-892 form."

Consistent with the requirements specified in the MPEP, applicants kindly request that the Examiner consider all the references cited in the ISR. Applicants enclose herewith, for the convenience of the Examiner, copies of the foreign patent publications and "other documents" listed but not considered. Applicants speculate that the copies became separated from the file within the Patent Office when the file was misplaced and erroneously considered abandoned, as can be seen by a review of the file history. Applicants also request that the patent publications and other documents be listed on any patent which may issue from this application, the applicants having provided a Form PTO-1449, constituting a separate listing of the cited publications.

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Status of Claims

Claims 1, 2 and 19-36 are pending and all are rejected. Claims 1, 2, 19-21, 23-25, 30-33, 35 and 36 are rejected as anticipated by U.S. Patent No. 4,436,119 to Shahan et al. Claims 1, 23, 24 and 32 are rejected as anticipated by U.S. Patent No. 4,122,640 to Commins et al. Claims 1, 21, 23, 32, 35 and 36 are rejected as anticipated by U.S. Patent No. 340,691 to Aldrich. Claims 22 and 29 are rejected as obvious over Shahan et al in view of U.S. Patent No. 3,523,395 to Rutter et al. Claims 26-28 are rejected as obvious over Shahan et al in view of U.S. Patent No. 2,928,565 to Glasoe, Jr. Claim 34 is rejected as obvious over Shahan et al in view of U.S. Patent No. 6,399,186 to Matthews et al.

The Argument

Applicants respectfully traverse the rejections, contending that the cited references Shahan et al, Commins et al and Aldrich fail to meet the requirements necessary to support a rejection of the amended claims on the basis of anticipation or obviousness. This is shown on a claim-by-claim basis in the arguments presented below.

Claim 1

To anticipate a claim, the reference must teach every element of the Claim. Claim 1, as amended, recites an insulation module for a process vessel, the module having an outer surface layer and a thermal insulation layer opposing a portion of the outer wall of the process vessel. Brackets are secured to the outer surface layer of the insulation module. The brackets extend toward the outer wall of the process vessel and are secured directly to the outer wall. An example of such a bracket is illustrated in Figures 1 and 2 of the application, wherein the bracket 7 is attached to outer surface layer 3 and extends through insulation layer 5 to the

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outer wall of process vessel 2, where a mounting leg 8 is attached directly to the outer wall by a cleat 16.

Shahan et al does not disclose the structure recited in amended Claim 1. There is, in fact, no direct connection in Shahan et al between the outer surface layer 12 and the outer wall of pipe 11 as shown in Figure 2 of the reference. Outer wall 12 is attached to an inner lining 14 by the insulation layer 13 or a vibration isolator 22, shown in detail in Figure 4. In turn, an isolation spacer 15 (see Figure 2) is positioned between the inner lining 14 and the outer wall of pipe 11, the isolation space 15 being on the opposite side of inner lining 14 from the vibration isolator 22. There is however, no bracket that attaches outer surface layer 12 directly to the outer wall of pipe 11 as recited in Claim 1. Lacking this element, Shahan et al cannot properly support a rejection of Claim 1 on the basis of anticipation because all claim elements are not taught by the cited reference.

Similarly, Commins et al does not teach the use of brackets secured to the outer surface layer of an insulating module, the brackets being directly securable to the outer wall of the process vessel. Commins et al, as shown in Figures 2 and 5, teaches using a fastener device 30 to attach a projecting flange element 14 to a wire cable 26 that is wrapped around the vessel wall 24. There is again, no bracket making a direct connection between the outer surface layer 12 of the insulation module 10 and the outer wall 24 of the process vessel 25 as recited in Claim 1.

With respect to Aldrich, there is no attachment of the insulating module to the pipe "A". Rivets "C" are locked in a sheet metal plate "B", merely rest on the pipe "A" and make no connection to the exterior cover "I". Similarly, the bolts "L" connect the exterior cover "I" to the sheet metal plate

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"B" to hold the insulating layers of paper "H", and felt "G" together. The bolts "I" are not connected to the pipe "A", the insulation module being retained to the pipe by bands "K'" and bolts "M" as stated in Aldrich at lines 72-82. This passage clearly indicates that the insulation assembly is first assembled and then placed around the pipe "A". There is no mention of any attachment in the form of a bracket between the exterior cover "I" and the pipe. In fact, it appears that the insulation module is free to slide longitudinally along the pipe once installed. This is different from applicants' module, wherein the brackets attach the outer surface layer of the module to the outer wall of the vessel as recited in Claim 1. Applicants contend that Aldrich fails to teach all elements of Claim 1 and, therefore, cannot properly be rejected as anticipated by this reference.

Claims 2, 19-23 and 25-36

Claims 2, 19-23 and 25-36 depend, either directly or indirectly, upon Claim 1 and should be allowable for the same reasons that Claim 1 is allowable.

Additionally, Claims 26-28 are rejected as obvious over Shahan et al in view of Glasoe Jr., the Examiner contending that Glasoe Jr. teaches providing a vessel with brackets 22 to secure insulation panels to a vessel, and that it would be obvious to modify Shahan et al by the addition of such brackets.

Contrary to the Examiner's position, applicants assert that there is no motivation to modify Shahan et al by using the brackets 22 of Glasoe Jr. between the outer wall of pipe 11 and the outer surface layer 12 of the insulation module 10 (see Figure 2 of Shahan et al) because such a modification would render the insulation module taught in Shahan et al unsatisfactory for its intended purpose. Shahan et al uses

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vibration dampers 22 specifically to isolate the outer surface layer 12 from the pipe 11 "to completely eliminate any acoustical vibrations from being transmitted from the piping 11 to the lagging 12..." (column 2, lines 19-21). Use of any bracket in Shahan et al that directly connects the lagging 12 (outer surface layer) to the pipe 11, as recited in applicants' Claim 1, would transmit vibration directly from the pipe 11 to the outer surface 12, and would defeat an express purpose of the insulation layer. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (MPEP, section 2143.01.)

If, as demonstrated above, there is no suggestion or motivation to make the proposed modification, then the cited references Shahan et al and Glasoe Jr. fail to meet the requirements necessary to establish a *prima facie* case of obviousness, because one of the three criteria necessary to establish obviousness requires that there be some motivation for the proposed modification. Clearly, by the authority cited above, a modification of Shahan et al that would render it unsatisfactory for its intended purpose of isolating acoustic vibration cannot properly be used to support a rejection on the basis of obviousness, as any logical motivation for the modification is lacking.

Summary

Applicants have demonstrated in the arguments presented above, that the cited references fail to anticipate applicants claims as amended because they fail to teach all claim elements, i.e., there is no teaching of the structure recited in the claims in any one reference. Furthermore, applicants have shown that there is no motivation to modify Shahan et al by adding brackets as taught in Glasoe Jr. because the

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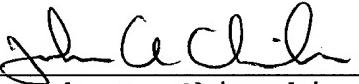
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proposed modification would render Shahan et al unsatisfactory for its intended purpose. Without motivation, a prima facie case of obviousness cannot be established, and the rejection of applicants claims on this basis is, therefore, improper. Applicants contend that the claims are allowable over the cited references and request that the application be passed to issue.

Respectfully submitted,

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